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DOCKET NO. 01-MV-0111

SERIAL NO. 10/034,751

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REMARKS

The Examiner is thanked for his Office Action.

Claims 1-21 are pending in the application, and were each rejected. All rejections are traversed below.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTIONS -- 35 U.S.C. § 102

Claims 1-8, 10-17 and 19-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,151,074 to *Werner*, hereinafter "*Werner*". This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Claim 1 requires, among other limitations, "a controller capable of dividing the digital still image file into a plurality of sub-picture files, the controller further capable of constructing an MPEG video stream from the plurality of sub-picture files" (emphasis added). This feature is not taught or suggested at all by *Werner*. *Werner* does mention in col. 5 that it "can be" for still or full-motion

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decompression algorithms, but does not then teach anything concerning a still image decompression algorithm.

Specifically, at no point does Werner teach or suggest anything related to dividing a still image file into a plurality of sub-picture files. In fact, Werner doesn't teach anything about files at all. Werner clearly cannot anticipate independent claim 1 or dependent claims 2-9.

The Examiner responds that "Werner does teach, 'Decoding engine processor programmed to decompress video data. Also Werner teaches various compression standards include JPEG and MPEG program to decompress still or motion algorithms (column 5 lines 27-58).'" For convenient reference, this passage reads:

Decoding engine 24 is a processor programmed to decompress the video data. It may be programmed to support various compression standards, such as the JPEG, MPEG, MPEG2, Px64, CCITT, etc. The programming can be for either still or full-motion decompression algorithms. Decoding engine 24 could be a multi-format decoding engine, switchable between decompression algorithms to perform whatever decompression method is appropriate for the input signal. The output of decoding engine 24 is decompressed pixel data which, in the example of this description, is in YCbCr format.

An example of a suitable decoding engine 24 is the decoding engine of the CL450 MPEG Video Decoder manufactured by C-Cube Microsystems. It provides decompressed YCrCb data with an image size consistent with the input signal.

A decoding engine bus 22b carries control information and data between decoding engine 24 and memory manager 22. The control information includes requests for data from decoding engine 24, which requests data as needed for processing. In response to a request, memory manager 22 generates the address of the next data to be decoded, retrieves the data from memory 23, and delivers it to decoding engine 24. Bus 22b is bidirectional--after decompression, decoding engine 24 delivers the data back to memory manager 22, which generates an address for storing it in memory 23.

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It is clear that nothing in this passage teaches or suggests anything related to dividing a still image file into a plurality of sub-picture files, or anything at all about files.

The Examiner further responds (entire quotation *sic*):

It is inherent JPEG or MPEG decoder to divide digital still image in to plurality Macroblock or block and reconstruct to a picture frame. There is no difference between constructing an MPEG video from the plurality of sub-picture and constructing an MPEG video from plurality of Macroblock since sub-picture made of plurality blocks.

Nothing at all in Werner teaches or suggests dividing a digital still image file into a plurality of sub-picture files, as claimed. This is not "inherent" to anything Werner teaches, nor to any part of the JPEG or MPEG standard. Nothing in the art of record even teaches that the claimed "dividing a digital still image filed into a plurality of sub-picture files" may even happen. Even the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

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necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Here, the Examiner has made no showing at all that anything in MPEG, JPEG, Werner, or any other art of record necessarily includes the claimed function of dividing a digital still image file into a plurality of sub-picture files.

The Examiner further states that "Also MPEG video is made of a plurality image file or frames." While an MPEG video, when played, displays a series of frames, it is factually incorrect to say that MPEG video is "made of a plurality image file," to the extent the Applicant understands this statement.

Nothing in Werner, or any other art of record, alone or in combination, teaches or suggests a controller capable of dividing a digital still image file into a plurality of sub-picture files, as claimed. Nothing in Werner, or any other art of record, alone or in combination, teaches or suggests a controller capable of constructing an MPEG video stream from the plurality of sub-picture files, as claimed.

Claim 11 includes similar language, and so Werner also does not anticipate independent claim 11 or dependent claims 12-18. Claim 18 requires dividing a digital still image file into a plurality of sub-picture files, and so Werner similarly cannot anticipate independent claims 19 or dependent claims 20-21.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejection with respect to these claims.

As such, all claims distinguish over Werner.

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II. CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 9, 18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Werner in view of U.S. Patent No. 6,728,317 to *Demos*, hereinafter "*Demos*". The Applicant(s) respectfully traverse the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Demos similarly fails to teach or suggest anything related to dividing a still image file into a plurality of sub-picture files, and so cannot teach or suggest the limitation that is missing from Werner. As neither Werner nor *Demos* teach or suggest this or similar features as required by each independent claim, neither can any combination of these references meet the limitations of the claims.

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Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

All rejections are traversed, and reconsideration and allowance are respectfully requested.

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CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date:

Feb 20, 2007

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